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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/532,561	04/25/2005	Jorg Pastre	12810-00074-US	4862
30678	7590	09/18/2006	EXAMINER	
CONNOLLY BOVE LODGE & HUTZ LLP			PUTTLITZ, KARL J	
P.O. BOX 2207				
WILMINGTON, DE 19899-2207			ART UNIT	PAPER NUMBER
			1621	

DATE MAILED: 09/18/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No.	Applicant(s)	
	10/532,561	PASTRE ET AL.	
	Examiner	Art Unit	
	Karl J. Puttlitz	1621	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

1) Responsive to communication(s) filed on 25 April 2005.

2a) This action is FINAL.                    2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

4) Claim(s) 1-19 is/are pending in the application.

4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

5) Claim(s) \_\_\_\_\_ is/are allowed.

6) Claim(s) 1-4, 6- 8 and 11-19 is/are rejected.

7) Claim(s) 5,9 and 10 is/are objected to.

8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) All    b) Some \* c) None of:

- Certified copies of the priority documents have been received.
- Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
- Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

1) Notice of References Cited (PTO-892)

2) Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date various.

4) Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.

5) Notice of Informal Patent Application

6) Other: \_\_\_\_\_.

## DETAILED ACTION

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-4, 6- 8 and 11-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6,992,212 to Zehner et al. (Zehner) in view of EP 0196520 (EP 520).

The claims are drawn to, *inter alia*, a process for the joint preparation of (i) formic acid (III); (ii) a carboxylic acid having at least two carbon atoms (II) and/or derivatives thereof; and (iii) a carboxylic anhydride (VII); said process comprising: (a) transesterifying a formic ester (I) with a carboxylic acid having at least two carbon atoms (II) to form formic acid (III) and the corresponding carboxylic ester (IV); (b) carbonylating at least part of the carboxylic ester (IV) formed in step (a) to form the corresponding carboxylic anhydride (V); and (c) transanhydriding at least part of the carboxylic anhydride (V) formed in step (b) with a carboxylic acid (VI) to form a carboxylic anhydride (VII) and the carboxylic acid (II).

With regard to the above embodiments, Zehner teaches a process for the joint preparation of formic acid and a carboxylic acid having at least two carbon atoms and/or derivatives thereof, wherein a) a formic ester (I) is transesterified with a carboxylic acid having at least two carbon atoms (II) to form formic acid (III) and the corresponding

carboxylic ester (IV); and b) at least part of the carboxylic ester (IV) formed in step (a) is carbonylated to give the corresponding carboxylic anhydride (V). See column 5, lines 4-15.

Formic acid, methyl formate and acetic anhydride are used as reagents, see embodiment 1, column 25.

Zehner fails to explicitly teach transanhydriding at least part of the carboxylic anhydride (V) formed in step (b) with a carboxylic acid (VI) to form a carboxylic anhydride (VII) and the carboxylic acid (II). However, it is for this proposition that the examiner joins EP 520 which teaches acid catalyzed transanhydridation with distillation. Those of ordinary skill would have been motivated to modify the disclosure of Zehner to include a transanhydridation step since EP 520 teaches that this is an effective way to provide a desired anhydride.

Applicant cannot rely upon the foreign priority papers to overcome this rejection because a translation of said papers has not been made of record in accordance with 37 CFR 1.55. See MPEP § 201.15.

### ***Double Patenting***

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir.

1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-4, 6- 8 and 11-19 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-11 of Zehner (above) in view of EP 520.

Although the claims of Zehner fail to explicitly recite transanhydriding at least part of the carboxylic anhydride (V) formed in step (b) with a carboxylic acid (VI) to form a carboxylic anhydride (VII) and the carboxylic acid (II), EP 520 which teaches acid catalyzed transanhydridation with distillation. Those of ordinary skill would have been motivated to modify the claims of Zehner to include a transanhydridation step since EP 520 teaches that this is an effective way to provide a desired anhydride.

Claims 5, 9 and 10 are objected to for dependency on one or more rejected claims, and therefore, would be allowable if rewritten in independent form, including all limitations of intervening claims.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Karl J. Puttlitz whose telephone number is (571) 272-

0645. The examiner can normally be reached on Monday to Friday from 9 a.m. to 5 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thurman K. Page, can be reached at telephone number (571) 272-0602. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Karl J. Puttlitz  
Assistant Examiner